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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,500	11/21/2001	John L. Wasula	79564APRC	3356

7590 10/25/2010
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EXAMINER

DANIELS, ANTHONY J

ART UNIT	PAPER NUMBER
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2622

MAIL DATE	DELIVERY MODE
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10/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,500	Applicant(s) WASULA ET AL.	
	Examiner ANTHONY J. DANIELS	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25, 27, 28, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25, 27, 28, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment, filed 7/1/2010, has been entered and made of record. Claims 21-25,27,28,31 and 32 are pending in the application.
2. Due to a closer examination of the prior art, the examiner believes features of claim 26 of the claims dated 10/3/2005 are no longer allowable. During a phone conversation with Peyton Watkins, permission for examiner's amendment was granted to amend claim 21 with the full features of previously allowable claim 26. While those features are not currently made of record, the examiner has searched these features and provided a reference, discussed below, concerning those limitations. This Office Action is Non-Final.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the withdrawal of allowability of claim 26 of the claims dated 10/3/2005.

Claim Objections

Claim 21 is objected to because of the following informalities: In section (a) of the claims, "images files" should be image files. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 2622

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The preamble of claim 27 recites a computer program product per se. The USPTO recognizes this subject matter as non-statutory. The examiner suggests amending the claim to recite, “A computer program product comprising a computer storage medium stored a computer program having instructions therein for causing the external device to perform the method of claim 21.”, in order to overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-24,27,28 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (US # 6,167,469).

As to claim 21, Safai teaches a method for transferring customized image files stored in a memory of a digital camera (Col. 12, Lines 63-67) to an external device (Col. 8, Lines 61-67; *{External device is the computer that the email which contains the images is checked.}*) having an external device database (Figure 6), using a camera database having at least one customizable

Art Unit: 2622

profile containing a set of image utilization fields (Col. 12, 63-67; Col. 13, Lines 1-6), comprising the steps of:

(a) transferring a plurality of image files from the memory to the external device (Col. 6, Lines 5-12);

(b) accessing the set of image utilization fields (*The computer must access the email address to send the images to the correct email address.*});

(c) modifying each transferred image file in accordance with the set of image utilization fields (Figure 5, *{If a voice message is checked, the images are modified in that a voice message will be attached with them.}*);

(d) storing the modified transferred image file in the external device (Figure 4F, To: “468”); and

(e) updating the camera database and the external device database so that both the camera database and the external device database include the same profiles (Figure 4E, Send button “458”; *{Sending the image profile makes the profile stored in the external device and the camera database.}*).

As to claim **22**, Safai teaches the method according to claim 21 wherein the set of image utilization fields is stored on the external device (*It is inherent that the words gwang@photoaccess.com are stored in the external device.*).

As to claim **23**, Safai teaches the method according to claim 21 further including the step of editing the customizable profile in the external device (*After sending, it is inherent that the message is no longer available.*).

As to claim **24**, Safai teaches the method according to claim 21 wherein the image utilization fields include a deletion field and further including the step of deleting the transferred image files from the memory in accordance with the deletion field after storage of such image in the external device (Figure 4F, Delete Pictures after Sending “474”).

As to claim **27**, Safai teaches a computer program product having instructions therein for causing the external device to perform the method of claim 21 (Col. 8, Lines 15-27).

As to claim **28**, the limitations of claim 27 can be found in claim 21 (a). Therefore, claim 27 is analyzed and rejected as previously discussed with respect to claim 21.

As to claim **32**, Safai, as modified by Kuba, teaches the method of claim 21 wherein the external device is a network service provider (Col. 6, Lines 5-19).

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2622

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US # 6,175,003) in view of Roberts et al. (US # 6,496,222).

As to claim **25**, Safai teaches a method according to claim 21. The claim differs from Safai in that it requires the image utilization files include an image editing preference application software field designating a software application stored in the external device and further including the step of applying the designated user preferred application software to the modified transferred captured image.

In the same field of endeavor, Roberts et al. teaches an image utilization field which includes an image editing preference application software field designating a software application stored in the external device and further including the step of applying the designated user preferred application software to the modified transferred captured image (see Figure 14A, “APPLE V1”, “IBM V2”; Col. 12, Lines 16-35). In light of the teaching of Roberts et al., it would have been obvious to one of ordinary skill in the art to modify include in the image utilization fields of Safai an image preference application software field. The modification of including a software application program field would allow the user to avoid erroneous image transfer due to incompatibility with the right software application program (see Roberts et al., Col. 12, Lines 37-42).

2. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US # 6,175,003) in view of Kuba et al. (US # 5,806,572).

As to claim **31**, Safai teaches the method of claim 21. The claim differs from Safai in that it requires the set of utilization fields include a filename suffix or filename prefix appended to the camera filenames.

In the same field of endeavor, Kuba et al. teaches a filename suffix appended to the camera filename (see Figure 60, suffix “J6C”). In light of the teaching of Kuba et al., it would have been obvious to one of ordinary skill in the art to include a filename suffix appended to the names of the camera filenames of the image files of Safai. Such modifications would allow for the user to easily specify compression type; consequently, allowing for faster transmission of images.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. As to US 2005/0012941, Takahashi teaches a method of transferring image files from a digital camera (Figure 1, digital camera “100”) to an external device (Figure 1, printer “200”) with information regarding how to utilize the image. Before the image transfer, the utilization information is first sent to the external device from the camera ([0027], Lines 1-10).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY J. DANIELS whose telephone number is (571)272-7362. The examiner can normally be reached on 8:00 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J Daniels/
Examiner, Art Unit 2622

10/24/2010